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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,243	07/31/2001	Raghavan Rajagopalan	MRD / 69	2807

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EXAMINER
SAUNDERS, DAVID A

ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N.	Applicant(s)
919,243	RAJAGOPALAN et al
Examiner	**Group Art Unit**
SAUNDERS	1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-66 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☑ Claim(s) 1-66 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ Th proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ Th drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 and 33-43, drawn to compounds and compositions with conjugated dyes, classified in class 530, subclasses 387.2 and 391.3+, as well as class 435, subclass 965.

II. Claims 9-15 and 44-48, drawn to in vivo imaging methods, classified in class 424, subclasses 9.6+, 131.1 and 178.1+.

III. Claims 16-24 and 49-61, drawn to compounds and compositions conjugated to a photosensitizer, classified in class 530, subclasses 387.2 and 391.7+, as well as class 435, subclass 965.

IV. Claims 25-32 and 62-66, drawn to in vivo therapeutic methods using a conjugate with a photosensitizer, classified in class 424, subclasses 9.6+, 131.1 and 178.1+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of group I has other uses, such as in immunoassays. It is well know in the immunoassay art to use anti-idiotypic antibodies (anti-Id Abs) as mimetics for antigens. It is also well know to use antigens conjugated to fluorescer/luminescer labels in immunoassays. Thus the claimed conjugate compounds/compositions could be used in an immunoassay for an analyte such as a steroid, a cardiac glycoside, somatostatin, etc.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of group III has other uses, such as in immunoassays. See above paragraph regarding the use of anti-Id-Abs. The recited photosensitizers (e.g. claim 16, lines 11+) could be used as electroactive labels in immunoassays for various analytes, as noted in the above paragraph. Also the conjugates with a photosensitizer could be used to sterilize medical devices in vitro.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different moieties conjugated to the internal image antibody. These different moieties are used in materially different processes, namely imaging or therapy. For like reasons the inventions of Groups II and IV are considered to be drawn to unrelated methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and different required searches, restriction for examination purposes as indicated is proper.

For whatever group is elected the following election of species holds.

This application contains claims directed to the following patentably distinct species of the claimed invention: each of the various species of biological receptors – e.g. those recited in claim 1 lines 5+. These receptors bind to a diverse set of ligands and would be related to a

variety of dissimilar disease states. Thus a teaching of the imaging or treatment of a disease involving one of these receptors would not show or suggest the imaging or treatment of a disease involving one of the other recited receptors.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 9-17, 25-36, 44-54 and 62-66 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Saunders, PhD whose telephone number is 703-308-3976. The examiner can normally be reached on Mon.-Thu., 8:00 am-5:30 pm and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 703-308-3973. The fax phone number for the organization where this application is assigned is 703-872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

David A Saunders

DAS
March 22, 2003.

DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT ~~182~~ 1644